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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/671,184	09/25/2003	Glenn M. Rosen	J745-001 US	6389

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NOTARO AND MICHALOS
100 DUTCH HILL ROAD
SUITE 110
ORANGEBURG, NY 10962-2100

EXAMINER

STASHICK, ANTHONY D

ART UNIT	PAPER NUMBER
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3728

DATE MAILED: 04/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

SP

Office Action Summary	Application No. 10/671,184	Applicant(s) ROSEN ET AL.	
	Examiner Anthony Stashick	Art Unit 3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-19, 21, 23-25 and 29 is/are rejected.
- 7) ☒ Claim(s) 20, 22, 26-28 and 30 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>09252003</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities: reference number “72” was defined as “connection bridge” on page 16, paragraph [0071], lines 2 and later referred to as “tooth” in line 4 of the same paragraph. Furthermore, it was referred to as “pivot connection” on page 16, paragraph [0072], line 5. Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1 and 18 contain the phrase “being flexible if necessary...” which renders the claims so. It is not clear whether the sole portion is flexible or not and therefore, the metes and bounds of the claims cannot be determined.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 3, 5-8, 10 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by the European reference to Bunke 0326304 (Bunke '304). Bunke '304 discloses all the limitations of the claims including the following: an upper portion (31a, 32a, 34) having at least one of a toe portion 31a for receiving the toe of a shoe, a heel portion 32a for receiving the heel of a shoe and an intermediate portion 34 for receiving an intermediate part of a shoe; a sole portion 30 connected to the upper portion; the upper portion including at least one self-supporting and resilient shoe admission portion (31a, 32a, 34) connected to the sole portion; the shoe admission portion having an inwardly inclined lead-in surface extending toward the sole portion (see Figure 5, lead in is inside of 31a and 32a) and an overhang surface extending from the lead-in surface toward the sole portion (hooked portion of 31a, 32a); the overhang surface being adapted to form an undercut area (that portion where sole of boot enters as shown in Figure 10) so that a shoe to be held to the shoe cover first engages and slides along the inclined lead-in surface to resiliently expand the admission portion outwardly without being crushed then slides into engagement with the overhang surface to enter or form the undercut area as the shoe touches the sole portion while the shoe admission portion contracts resiliently inwardly to hold the shoe (see Figure 10); the overhang surface is adapted to extend outwardly of the lead-in surface to form the undercut area (see Figures 5 and 10), with and without the shoe being engaged into the undercut area; the toe and heel portions each include at least one admission portion (see Figures 5 and 10); the intermediate portion includes at least one admission portion 34; the lead-in and overhang surfaces are smooth curved surfaces that extend contiguously one next to the other (see 31a and 32a in Figure 5); the admission portion is a curved sheet of self-supporting resilient material connected to the sole portion (see Figures 5 and 10).

6. Claims 1, 3, 5-7, 10, 14, 16, 18, 19, 21, 23, 25 and 29 are rejected under 35 U.S.C. 102(b) as being anticipated by Pollard 5,666,746. Pollard '746 discloses all the limitations of the claims including the following: an upper portion 20, 22 having at least one of a toe portion 20 for receiving the toe of a shoe, a heel portion 22 for receiving the heel of a shoe and an intermediate portion for receiving an intermediate part of a shoe; a sole portion 12, 14 connected to the upper portion; the upper portion including at least one self-supporting and resilient shoe admission portion 20, 22 connected to the sole portion; the shoe admission portion having an inwardly inclined lead-in surface extending toward the sole portion (see Figures 3 and 6 above 26 and 28) and an overhang surface extending from the lead-in surface toward the sole portion (see Figures 3 and 6 at 26 and 28); the overhang surface being adapted to form an undercut area so that a shoe to be held to the shoe cover first engages and slides along the inclined lead-in surface to resiliently expand the admission portion outwardly without being crushed then slides into engagement with the overhang surface to enter or form the undercut area as the shoe touches the sole portion while the shoe admission portion contracts resiliently inwardly to hold the shoe (see Figure 6); the overhang surface is adapted to extend outwardly of the lead-in surface to form the undercut area (see Figures 3 and 6), with and without the shoe being engaged into the undercut area; the toe and heel portions each include at least one admission portion (see Figures 1-3 and 6); the lead-in and overhang surfaces are smooth curved surfaces that extend contiguously one next to the other (see Figures 3 and 6); the admission portion is a curved sheet of self-supporting resilient material connected to the sole portion (see Figures 3 and 6); length adjusting means 24 connected to the sole portion for adjusting the length of the shoe cover; length adjusting means including biasing means (portion 24) for adjusting the length of the sole portion, lock means 44,

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46 for holding the sole portion at a plurality of lengths, and release means (pull apart 44 from 46 in Figure 1) for releasing the lock means to allow the sole portion to adjust in length under the bias of the biasing means.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 9 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pollard 5,666,746 as applied to claims 1 and 19 above in view of Carey 4,299,037. Pollard '746 as applied to claims 1 and 19 above discloses all the limitations of the claims except for the shoe cover having at least two admission portions in the upper with a slot between the at least two admission portions forming resilient fingers for holding the shoe to the shoe cover. Carey '037 teaches that the upper of a shoe cover can have finger portion 22, 32 formed by slots between the cover portions to allow for the toe connecting members to bend inward and help hold the cover on the shoe. Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to make the upper of the cover of Pollard '746, out of fingers to allow for better flexibility of the upper, make it lighter in weight and to allow for the top portion of the fingers to easily curve inward to help hold the cover on the shoe of the user.

Conclusion

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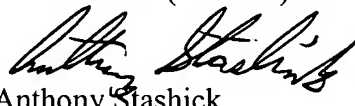
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9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure and are cited on form 892 enclosed herewith.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony Stashick whose telephone number is 571-272-4561. The examiner can normally be reached on Monday-Thursday 8:30 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Anthony Stashick
Primary Examiner
Art Unit 3728

ADS